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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,219	04/09/2001	Antonio Montserrat Gibernau	932.1194	8578
21831	7590	11/07/2003	EXAMINER MADSEN, ROBERT A	
STEINBERG & RASKIN, P.C. 1140 AVENUE OF THE AMERICAS, 15th FLOOR NEW YORK, NY 10036-5803			ART UNIT 1761	PAPER NUMBER

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/829,219

Applicant(s)

MONTERRATE GIBERNAU,  
ANTONIO

Examiner

Robert Madsen

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The Amendment filed July 28, 2003 has been entered. Claim 15 has been added. Claims 1-15 remain pending in the application.
2. The rejections made under 35 U.S.C. 112 are hereby withdrawn.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claim 1 recites the inner wrapper is "capable of transmitting heat or steam" to the outer package. However, in the specification the inner wrapper is disclosed as (1) "includes on its lower part, incorporated into the inner wrapper itself, a layer of heat concentrating material (susceptor)" (Page 7, lines 9-13) or (2) "made of ordinary paper" (Page 8, lines 1-3). The specification is not enabling for transmitting steam, and does not disclose what is meant by "capable of transmitting steam" (e.g. via a porous surface).

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1,5,11,13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Levinson (US 4390554).
7. Levinson teaches a microwave package (Column 3, lines 23-56) comprising an outer polyethylene film, as recited in claim 11,(film 4 of Figure 1) that has a portion that melts during heating (item 13,Column 4, lines 30-45), an outer paper substrate as recited in claim 5 (column 3, lines 51-54, insulation 5 of Figure 1) attached to an outer face of the outer package , an inner paper wrapper, as recited in claim 11, (item 3 of Figure 1) containing food (item 1 of Figure 1) which is capable of transmitting both heat and steam since the inner paper layer contains salt water, and thus also a "strip" of heat-concentrating material as recited in claim 13, wherein under microwave radiation the salt water boils and its hot vapor (i.e. both steam and heat are transmitted) heat up the food (i.e. 14 in layer 3, Column 5, lines 24-42) as recited in claims 1 and 15.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claim 2,6, 9,and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable Levinson (US 4390554) as applied to claims 1,5,11,13, and 15 in view of Borek (US 4219573).

10. Regarding claims 2,6,and 10, Levinson teaches it may be necessary to insulate the package from a cool oven surface (Column 4, lines40-45), but Levinson is silent in teaching a heat insulating layer attached to the *inner* part of the outer package as recited in claim 2 by an adhesive as recited in claim 10 and may be attached to the inner wrapper as recited in claim 6 as two sheets and an insulated material between. Borek is relied on as evidence that heat is lost in microwave packages to the microwave floor, as acknowledged by Levinson, and teaches providing a heat insulating layer (item 8) glued to the *inner* part of the outer package to make heating more efficient (Column 3, line 14 to Column 4, line 16 ), and may comprise two sheets and insulation material (i.e. corrugated paper , Figures 1 and 2) attached to the inner wrapper. Therefore, it would have been obvious to include a heat-insulating layer glued to the inner part of the outer package since Levinson teaches insulating the package from the oven surface may be necessary and Borek teaches gluing an insulating layer to the outer package will improve heating efficiency. It also would have been obvious to attach the insulating layer to the inner wrapper wherein the layer comprises two sheets and insulation material (i.e. corrugated paper , Figures 1 and 2) since Borek teaches corrugated paper attached to the inner wrapper.

11. Regarding claim 9, Levinson teaches the substrate is attached to the outer wrapper, but is silent in teaching adhesive. Borek , as discussed above, teach adhering supplemental layers (e.g. insulating layers) to an outer wrapper is done with adhesive (Column 3, line 14 to Column 4, line 16 ). Therefore, it would have been obvious to use adhesive to attach the substrate to the outer wrapper since Borek teaches adhesive as

a suitable means for attaching a supplemental layer to the outer wrapper and one would have been substituting one conventional means for attachment for another.

12. Claims 1, 3-5, 7, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engstrom et al. (US 4734288) in view of Cox (US 5679278).

13. Regarding claims 1, 4, 5, 11-14 Engstrom et al. teach a microwave popcorn package comprising an inner wrapper (item 29) capable of transmitting heat and steam (i.e. it transmits heat and steam by venting as described in Column 7, lines 4-20), a polyethylene based outer package that melts during heating (item 22, Column 5, line 64 to Column 6, line 43), and a paperboard based substrate as recited in claims 5 and 11 that is equal in size to the outer package as recited in claim 4 (i.e. container 10 attached to the polyethylene, Column 5, lines 37-65). Engstrom et al. further teach a weld line to facilitate opening during heating as recited in claim 12 (item 28). However, Engstrom et al. are silent in teaching a heat-concentrating material as recited in claim 1, providing a sheet of heat insulating material to an inner part of the outer package as recited in claim 2, that may be applied on the outer package as recited in claim 14, or in a form of a strip as recited in claim 13.

14. Heat-concentrating materials are well known in the microwave popcorn package art and are used as a means for increasing heat supplied to the popcorn. Cox who also teaches an inner wrapper (item 38), an outer package made of plastic material (i.e. item 40 is made from PET), and a substrate (item 42), like Engstrom et al., is relied on as evidence that heat-concentrating materials, including aluminum, (item 50) that *may be*

applied, depending on the shape and desired heating location, on the outer package as recited in claim 14 in a form of as strip as recited in claim 13 (Column 6, lines 20-54, Column 5, lines 42-65).

15. Therefore it would have been obvious to provide a heat concentrating layer as recited in claim 1 on the outer package as recited in claim 14 in a form of as strip as recited in claim 13 since Cox teaches it was known to optionally add a heat concentrating layer, depending on the shape of the package and where a heat source is required, and one would have been substituting one microwave package design for another for the same purpose: to prepare popcorn in the microwave in a package comprising an inner wrapper, outer plastic package, and substrate attached to an outer face of the outer package.

16. Regarding claim 3, Engstrom et al. teach paper, but are silent in teaching the paper is from a continuous web. Cox, however, teaches the conventionality of the substrate layer being made from a continuous web of paper material (kraft paper (Column 5, line 65 to Column 6, line 2, Figures 6, 7 and 20). Therefore, it would have been obvious to use a substrate layer made from a continuous web of paper material since one would have been substituting one supply of paper based substrate for another for the same purpose: a microwave popcorn package comprising an inner wrapper, outer plastic package, and substrate attached to an outer face of the outer package.

17. Regarding claim 7, Engstrom et al. are silent in teaching the heat-concentrating layer is coated on the insulating layer. Cox is relied on as evidence of providing the

heat-concentrating layer either on the outer package (item 40) or coating an insulating layer (item 42), which also serves as the substrate (Column 5, line 65 to Column 6, line 2, Column 6, line 20-31, 45-54, Figures 4 and 4a). Therefore it would have been further obvious to coat the insulating layer with the heat-concentrating layer since Cox teaches different locations for the heat concentrating layer and one would have been substituting one conventional microwave package design for another for the same purpose: to prepare popcorn in the microwave in a package comprising an inner wrapper, outer plastic package, and substrate attached to an outer face of the outer package.

18. Claims 2,6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engstrom et al. (US 4734288) in view of Cox (US 5679278) as applied to claims 1, 3-5, 7,11-14 above, further in view of Borek (US 4219573).

19. Engstrom et al. is silent in teaching a heat insulating layer attached to the inner part of the outer popcorn/oil package as recited in claim 2 by an adhesive as recited in claim 10, and may be attached to the inner wrapper as recited in claim 6 as two sheets and an insulated material between . However, Borek is relied on as evidence that heat is lost in microwave popcorn packages to the microwave floor and teaches providing a heat insulating layer (item 8) glued to the inner part of the outer package to make heating more efficient (Column 3, line 14 to Column 4, line 16 ). Furthermore, the insulating layer comprises two sheets and insulation material (i.e. corrugated paper , Figures 1 and 2) and may be attached to the inner wrapper. Therefore, it would have been obvious to include a heat insulating layer glued to the inner part of the outer

package since Borek teaches gluing an insulating layer to the outer package will improve heating efficiency for microwave popcorn packages and one would have been substituting one package design for another for the same purpose: preparing microwave popcorn. It also would have been obvious to attach the insulating layer to the inner wrapper wherein the layer comprises two sheets and insulation material (i.e. corrugated paper, Figures 1 and 2) since Borek teaches corrugated paper attached to the inner wrapper.

20. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engstrom et al. (US 4734288) in view of Cox (US 5679278) as applied to claims 1, 3-5, 7, 11-14 above, further in view of Smart et al. (US 4890439).

21. Engstrom et al. modified includes a heat-concentrating layer made from aluminum. Smart et al. are relied on as evidence of the conventional heat-concentrating layer comprising aluminum oxide (Column 6, lines 25-55). Therefore, it would have been obvious to include aluminum oxide since one would have been substituting one type of aluminum-based heat concentrating layer for another for the same purpose.

### ***Response to Arguments***

22. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive.

23. Applicant argues that Levinson does not teach the inner wrapper causes the outer wrapper to open by virtue of heating the inner wrapper. Claims 1 and 15 recite “

at least one layer of heat-concentrating material causes the opening of the outer package by melting a portion of the outer package, during heating of the assembly in a microwave oven. As stated and cited in the rejections above, Levinson teaches heat concentrating material item 14, which is salt water, generates hot vapors to heat up the food (Column 5, lines 24-40). Levinson also teaches the outer wrapper item 4 is designed to vent at a particular temperature and pressure during heating of the assembly in the microwave oven, and this particular venting feature includes using plastic that melts at a particular temperature (Column 4, lines 30-40). Since the salt-water is the source of heat in the package, then it does indeed result in melting a portion of the outer package, and therefore Levinson meets the recited limitation.

24. Applicant asserts that new claim 15 requires the wrapper, or inner paper wrapper, contacts the food. However, it is noted that this feature upon which applicant relies (i.e., the inner wrapper *contacting* the food) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Both claims 1 and 15 recite "an inner wrapper which *contains* the food." "Contains" does not require that the wrapper touch the food, as evidenced by Merriam-Webster Dictionary OnLine.

25. In response to applicant's argument that there is no suggestion to combine the Levinson and Borek references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Levinson teaches it may be necessary to insulate the package from the cold surface of the microwave oven, and Borek teaches including an insulating layer inside the outer wrapper for the same purpose. Thus Borek teaches a means to solve a problem acknowledged by Levinson: a cold oven surface.

26. In response to applicant's argument that there is no suggestion to combine the Engstrom and Cox references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Engstrom teaches a microwave popcorn assembly. Cox teaches that adding a heat-concentrating layer to a microwave popcorn package depends on the package shape and where heat may be required. Thus, Cox provides motivation for modifying Engstrom in that depending on the shape of the package and where heat needs to be applied, one may include a heat-concentrating layer for a microwave popcorn package.

***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

28. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (703)305-0068. The examiner can normally be reached on 7:00AM-3:30PM M-F.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703)308-3959. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


31. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0061.

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Robert Madsen  
Examiner  
Art Unit 1761



  
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